

SUPPORT FOR AMENDMENTS

Claims 1-32 are canceled without prejudice to their continued prosecution in a continuation and/or divisional application. New claims 33-39 are fully supported by canceled claims 1-3, 5-7, 12-13, and 16-17, and by the description in the specification (e.g., page 6, lines 1-27; page 6, line 34 to page 7, line 2; Examples 1-4 on pages 22-27; etc.). No new matter has been added. Upon entry of this Response, claims 33-39 are present and active in the application.

REMARKS

Claim Rejections

The written description rejection of claims 1, 2, and 8 under 35 U.S.C. § 112, first paragraph, the enablement rejection of claims 1-32 under 35 U.S.C. § 112, first paragraph, the indefiniteness rejection of claims 1, 2, 5, 8, 17, 24, and 31 under 35 U.S.C. § 112, second paragraph, the rejection of claims 1-17, 19-24, and 26-31 under 35 U.S.C. § 102(b), the new matter rejection of claims 1, 2, and 8-32 under 35 U.S.C. § 112, first paragraph, and the indefiniteness rejection of claims 12-13, 18-20, 24, 26-27, and 31 under 35 U.S.C. § 112, second paragraph have all been rendered moot by the cancellation of these claims. Accordingly, withdrawal of these grounds of rejection is respectfully requested.

For the record, Applicant notes that the cancellation of claims 1-32 was made without prejudice to their continued prosecution in a later filed continuation and/or divisional application. Applicants do not concede that the canceled claims are unpatentable for the reasons set forth in the Office Action, and take strong issue with the Examiner's characterizations of their positions with respect to these rejections (e.g., particularly the statement on page 15 of the Office Action that Applicants "have implicitly conceded" the unpredictability of the art).

New Claims

New claims 33-39 recite a specific type of monomeric unit (i.e., amino acids), a specific type of chain structure (i.e., linear), a specific type of marker group (i.e., luminescent metal chelates), and a specific type of solid phase binding group (i.e., biotin), all of which are described in Examples 1-4 of the specification.

Applicants note that the subject matter recited in new claims 33-39 conforms to subject matter indicated by the Examiner as satisfying both the written description requirement (e.g., page 6 of Office Action, lines 1-4) and the enablement requirement (e.g., page 10 of Office Action, section 11). Accordingly, the written description and enablement rejections raised against canceled claims 1-32 should not be applied against new claims 33-39.

Applicants further note that independent claims 33 and 34 recite that the carrier is linear, a feature that is neither taught nor suggested in the *Tam* reference (U.S. Patent No. 5,229,490), which describes dendritic structures. Accordingly, the rejection under 35 U.S.C. § 102(b) raised against canceled claims 1-17, 19-24, and 26-31 should not be applied against new claims 33-39.

Finally, Applicants note that the Markush recitation in new claims 33 and 34 that the side groups are selected from the group consisting of amino groups, thiol groups, "and a combination thereof" is fully supported by the description in the specification (e.g., page 9, lines 11-12), which states that "[t]he hapten molecules and marker or solid phase binding groups are preferably coupled to the carrier chain via reactive amino or/and thiol side groups" (emphasis added). Accordingly, the new matter rejection raised against canceled claims 1, 2, and 8-32 should not be applied against new claims 33-39.

Conclusion:

In view of the Amendments and Remarks set forth above, Applicants respectfully submit that the claimed invention is in condition for allowance. Early notification to such effect is earnestly solicited.

If for any reason the Examiner feels that the above Amendments and Remarks do not put the claims in condition to be allowed, and that a discussion would be helpful, it is respectfully requested that the Examiner contact the undersigned agent directly at (312)-321-4257.

Respectfully submitted,


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